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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/035,344 | 01/04/2002 | Daniel M. Cimora | 2318-288-II | 2255 |
| 6449 | 7590 | 06/14/2004 | EXAMINER | |
| ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005 | | | LANDSMAN, ROBERT S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1647 | |

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/035,344 | Applicant(s) CIMBORA ET AL. | |
| | Examiner Robert Landsman | Art Unit 1647 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-116 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-116 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Election/Restriction

- A. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-4, drawn to an isolated protein complex wherein the first protein is AKT1, classified in class 530, subclass 402.
 - II. Claim 5-6, drawn to an antibody, classified in class 530, subclass 387.1.
 - III. Claims 7-16, drawn to a method of diagnosing a physiological disorder, classified in class 435, subclass 7.2.
 - IV. Claims 17-26, drawn to a method of using a gene mutation, classified in class 530, subclass 387.1.
 - V. Claims 27-37, drawn to a non-human animal and a cell line derived from said animal, classified in class 800, subclass 3.
 - VI. Claims 38-45, drawn to a composition and cell line, classified in class 435, subclass 471.
 - VII. Claims 46-50 and 53, drawn to a method of screening drug candidates, classified in class 435, subclass 7.1.
 - VIII. Claims 51-52, 54 and 55, drawn to a drug of VII, class and subclass undeterminable.
 - IX. Claims 56 and 59-65, 68, 71, 72 and 84-86, drawn to a method of selecting modulators, classified in class 435, subclass 7.2.
 - X. Claims 57, 58, 66, 67, 69, 70, 73, 74, 87 and 88, drawn to modulators of IX, class and subclass undeterminable.
 - XI. Claim 75, drawn to a method of identifying compounds which bind a protein, classified in class 435, subclass 7.1.
 - XII. Claims 76 and 77, drawn to compounds of XI, class and subclass undeterminable.
 - XIII. Claim 78 and 81, drawn to a method of identifying compounds by selecting coordinates, class and subclass undeterminable.
 - XIV. Claims 79, 80, 82 and 83, drawn to the modulators identified in XIII, class and subclass undeterminable.
 - XV. Claims 89-95, drawn to a method of modulating a protein in a cell, classified in class 435, subclass 7.2.
 - XVI. Claim 96-116, drawn to a method of modulating a disorder in a patient, classified in class 514, subclass 2.

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B. The inventions are distinct, each from each other because of the following reasons:

Inventions I, II, V, VI, VIII, X, XII and XIV are independent and distinct, each from each other, because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged.

Inventions III, IV, VII, IX, XI, XIII, XV and XVI are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

C. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17 (h).


ROBERT LANDSMAN
PATENT EXAMINER

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Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
June 11, 2004